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6 a California Corporation

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FILED

MAY 21 2008

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND

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8 UNITED STATES DISTRICT COURT

9 NORTHERN DISTRICT OF CALIFORNIA

10 C. MONDAVI & SONS, a California
corporation

11 Plaintiff,

12 vs.

13 SAN ANTONIO WINERY, INC., a
14 California corporation; and DOES 1-100,
inclusive.

15 Defendants.

Case No.:

C08-02578

COMPLAINT FOR TRADEMARK
INFRINGEMENT, FALSE
DESIGNATION OF ORIGIN, UNFAIR
COMPETITION, AND COMMON LAW
TRADEMARK INFRINGEMENT

JURY TRIAL DEMANDED

ADR

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17 Plaintiff, C. Mondavi & Sons alleges:

18 1. **Jurisdiction.** This court has subject matter jurisdiction over this matter under 15
19 U.S.C. § 1121 and § 1125(d) and 28 U.S.C. §§ 1331 and 1338 (a) and (b). This civil action
includes counts for infringement of a trademark registered in the United States Patent and
20 Trademark Office, as authorized by the Trademark Act, for false designation of origin under
21 section 43(a) of the Lanham Act, for related claims of unfair competition and common law
22 trademark infringement. This court also has supplemental jurisdiction over this matter pursuant
23 to 28 U.S.C. § 1367(a) as to the unfair competition and common law trademark infringement
24 claims that are related to foregoing claims in the action within the court's original jurisdiction,
25 since they form part of the same case or controversy under Article III of the United States
26 Constitution.
27

GO 44 SEC. 11
NOTICE OF ASSIGNMENT
TO MAGISTRATE JUDGE SENT

1 2. **Venue.** Venue is proper in the Northern District of California pursuant to 28 U.S.C.
2 § 1391(b) and (c).

3 3. Plaintiff demands a jury trial. Fed. R. Civ. Pro. § 38(b); Federal CRC 3-6.

4 4. Since at least April 1996, Plaintiff, C. Mondavi & Sons ("Plaintiff") has used, both
5 on its own and through licensees, the mark GENERATIONS in connection with the production,
6 sale, and distribution of bottled wine products ("Plaintiff's Trademark").

7 5. Plaintiff is a renowned pioneer and innovator in the wine industry and has gained
8 national and international recognition in the mark GENERATIONS. As a result, Plaintiff's
9 mark has earned valuable goodwill.

10 6. As a result of Plaintiff's substantial advertising and promotional efforts for Plaintiff's
11 goods and services, as well as its dedication to providing quality services, Plaintiff's marks are
12 widely and favorably recognized and relied upon by the relevant trade and consuming public as
13 indicating high quality goods and services originating exclusively from Plaintiff. Due to such
14 efforts, Plaintiff's Trademark has earned very valuable goodwill.

15 7. In order to protect the extensive goodwill symbolized by Plaintiff's trademark, on
16 April 6, 1999, Plaintiff obtained a federal registration for its mark GENERATIONS in
17 connection with "wine" (U.S. Reg. No. 2,236,517). A true and correct copy of U.S. Registration
18 Number 2,236,517, dated April 6, 1999, is attached hereto as Exhibit A, and incorporated herein
19 by reference.

20 8. In or about April 2005, Plaintiff filed Combined Declaration of Use and
21 Incontestability under Section 8 & 15 (15 U.S.C. §§ 1058 & 1065) for its U.S. Trademark
22 Registration Number 2,236,517. The Combined Declaration was accepted by the United States
23 Patent Trademark Office in or about May 2005. An incontestable status upon the Principal
24 Register is conclusive evidence of the validity of the registered mark, of the registrant's
25 ownership of the mark, and the registrant's exclusive right to use the registered mark. Lanham
26 Act, 15 U.S.C. § 1115(b). A true and correct copy of the Notice of Acceptance of Incontestable
27 Status for U.S. Trademark Registration Number 2,236,517, dated May 20, 2005, is attached
28

1 hereto as Exhibit B, and incorporated herein by reference.

2 9. In or about December 2007, Plaintiff became aware that Defendant, San Antonio
3 Winery, Inc. ("Defendant") was using, or planning to use Plaintiff's trademark GENERATIONS
4 in connection with the manufacture and distribution of its wine.

5 10. On or about December 27, 2007, Plaintiff, through its trademark counsel, sent a letter
6 to Defendant insisting that it ceases and desists its planned use, or actual use of the mark
7 GENERATIONS in connection with its wine product.

8 11. In or about January and February 2007, Defendant acknowledged Plaintiff's
9 incontestable mark and assured Plaintiff that it would stop all anticipated or present use of the
10 mark GENERATIONS.

11 11. In spite of Defendant's assurances, Plaintiff is informed and believes that Defendant
12 has continued in its wrongful use of the GENERATIONS mark in connection with wine.

13 FIRST COUNT

14 (Trademark Infringement)

15 12. Since about December 2007, Defendant has been using, or is planning to use, the
16 trademark GENERATIONS in connection with the manufacture and distribution of its bottled
17 wine products.

18 13. GENERATIONS as used by Defendant is confusingly similar to the registered
19 trademark of Plaintiff. Defendant has used this confusingly similar mark in its advertising and
20 promotion.

21 14. The unlicensed use of any colorable variation of Plaintiff's trademark by Defendant
22 is likely to cause mistake or confusion or deception in the minds of the public and constitutes an
23 infringement of Plaintiff's federally registered trademark.

24 15. Because Plaintiff has no control over the nature of Defendant's unlicensed use of the
25 infringing mark, Plaintiff will be and is being damaged by Defendant's unauthorized use of the
26 mark, and Plaintiff's rights in its registered mark have been and will be diluted as a result of
27 Defendant's conduct, to Plaintiff's detriment.

1 16. The infringements charged above are knowing and willful infringements.

2 17. The goodwill of Plaintiff's business under its GENERATIONS registered trademark
3 is of enormous value, and Plaintiff will suffer irreparable harm if infringement is allowed to
4 continue to the detriment of Plaintiff's trade reputation and goodwill.

5 WHEREFORE, Plaintiff prays for judgment as hereinafter set forth.

6 SECOND COUNT

7 (False Designation of Origin; § 43(a) of the Lanham Act)

8 18. Defendant's use of the "GENERATIONS" mark constitutes a false designation of
9 origin that is likely to deceive customers and perspective customers into believing that
10 Defendant's line of products is that of the Plaintiff, and, consequently, is likely to divert
11 customers away from the Plaintiff.

12 19. Plaintiff has no control over the nature and quality of the line of products
13 manufactured and sold by Defendant. Plaintiff is informed and believes, and thereon alleges
14 that Defendant's bottled wine products are inferior to the product sold under Plaintiff's
15 GENERATIONS mark. Therefore, any failure, neglect or default by Defendant in providing
16 such products will impugn the integrity of Plaintiff's products and further reflect adversely on
17 Plaintiff as the believed source and origin thereof, hampering efforts by Plaintiff to continue to
18 protect its outstanding reputation for high quality, high precision products, resulting in loss of
19 sales thereof and the considerable expenditures to promote its products under the mark, all to the
20 irreparable harm of Plaintiff.

21 20. Defendant's false designation of origin will continue unless enjoined by this court.

22 THIRD COUNT

23 (Unfair Competition)

24 21. The use of Plaintiff's trademark, or any colorable imitation of it by the Defendant, is
25 likely to cause mistake, or confuse or deceive the general public.

22. The use of the name GENERATIONS by Defendant constitutes a knowing and willful passing off of the services of Defendant, for those of Plaintiff, and is a deception of citizens of the State of California and throughout the United States.

23. The actions of the Defendant constitute unfair competition with Plaintiff in the trade by reason of Defendant's use of a mark confusingly similar to Plaintiff's trademark.

24. These acts of by Defendant have caused and are continuing to cause irreparable injury to the reputation Plaintiff has established.

25. Unless the use of Plaintiff's trademark by Defendant is restrained, Defendant will continue these acts to the detriment of Plaintiff.

FOURTH COUNT

(Common Law Trademark Infringement)

26. The use of Plaintiff's trademark, or any colorable imitation of it by the Defendant, is likely to cause mistake, or confuse or deceive the general public.

27. The use of the name GENERATIONS by Defendant constitutes a knowing and willful passing off of the services of Defendant, for those of Plaintiff, and is a deception of citizens of the State of California and throughout the United States.

28. The actions of the Defendant constitute an infringement of Plaintiff's senior common law rights in the mark GENERATIONS by reason of Defendant's use of a mark confusingly similar to Plaintiff's trademark.

29. These acts of infringement by Defendant have caused and are continuing to cause irreparable injury to the reputation Plaintiff has established.

30. Unless the use of Plaintiff's trademark by Defendant is restrained, Defendant will continue these acts to the detriment of Plaintiff.

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1 WHEREFORE, Plaintiff prays for judgment as follows:

2 PRAYER

3 Plaintiff demands:

4 a. On the first count, that Defendant, its agents, servants, employees,
5 privies, successors, and assigns, and all claiming any rights through them, be restrained
6 following this suit and perpetually enjoined from:

7 (i) Using the name "GENERATIONS" or any name including its
8 singular variation, or any other colorable imitation of Plaintiff's registered trademark; and

9 (ii) Otherwise infringing Plaintiff's registered trademark;

10 b. On the first count, that Defendant account to the Plaintiff and pay the
11 Plaintiff all profits realized from the sale of goods or services under the name
12 "GENERATIONS";

13 c. On the first count, that the Plaintiff recover all damages sustained by
14 Plaintiff on account of the infringement;

15 d. On the second count, that Defendant be ordered to surrender for
16 destruction all products, name plates, labels, advertisements and other materials constituting
17 infringement of Plaintiff's designation of origin and infringement of U.S. Trademark
18 Registration No. 2,546,009;

19 e. On the third count, that the Plaintiff recover all damages sustained on
20 account of the unfair competition; and

21 f. On the fourth count, that Defendant, its agents, servants, employees,
22 privies, successors, and assigns, and all claiming any rights through them, be restrained
23 following this suit and perpetually enjoined from:

24 (i) Using the name "GENERATIONS" or any name including its
25 singular variation, or any other colorable imitation of Plaintiff's registered trademark; and

26 (ii) Otherwise infringing Plaintiff's registered trademark;

1 f. On the fourth count, that Defendant account to the Plaintiff and pay the
2 Plaintiff all profits realized from the sale of goods or services under the name
3 "GENERATIONS";

4 g. On the fourth count, that the Plaintiff recover all damages sustained by
5 Plaintiff on account of the infringement; and

6 h. For costs of suit and reasonable attorney's fees.

7 Dated: May 21, 2008

FITZGERALD ABBOTT & BEARDSLEY LLP

8
9 By 
10 William E. Adams
11 Attorneys for Plaintiff C. MONDAVI & SONS
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Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

Reg. No. 2,236,517

United States Patent and Trademark Office

Registered Apr. 6, 1999

**TRADEMARK
PRINCIPAL REGISTER**

GENERATIONS

**C. MONDAVI & SONS (CALIFORNIA CORPORATION)
2800 MAIN STREET
ST. HELENA, CA 94574**

**FIRST USE 4-25-1996; IN COMMERCE
4-25-1996.**

SER. NO. 75-344,136, FILED 8-20-1997.

**FOR: WINE, IN CLASS 33 (U.S. CLS. 47 AND
49).**

**ELIZABETH PASQUINE, EXAMINING ATTOR-
NEY**

Document Description: **Notice of Acceptance Acknowledgement** Mail / Create Date: **20-May-2005**



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 2236517 SERIAL NO: 75/344136 MAILING DATE: 05/20/2005
REGISTRATION DATE: 04/06/1999
MARK: GENERATIONS
REGISTRATION OWNER: C. MONDAVI & SONS

CORRESPONDENCE ADDRESS:

Katherine C. Spelman
DLA Piper Rudnick Gray Cary US LLP
Suite 3200
333 Market Street
San Francisco, CA 94105-2150

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF ACKNOWLEDGEMENT

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
033.

ROBERTS, SHARON YVONNE
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION
ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION**I) SECTION 8: AFFIDAVIT OF CONTINUED USE**

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

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- **Technical help:** For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](#), or call 1-800-786-9199.
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NOTE: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

JS 44 (Rev. 12/07) (and rev 1-16-08)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON PAGE TWO OF THE FORM.)

I. (a) PLAINTIFFS

C. Mondavi & Sons, a California corporation

DEFENDANTS

San Antonio Winery, Inc., a California corporation, and Does 1-100, inclusive

(b) County of Residence of First Listed Plaintiff
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Fitzgerald Abbott & Beardsley, LLP
1221 Broadway, 21st Floor
Oakland, CA 94612
(510) 444-3300

County of Residence of First Listed Defendant

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES	
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury—Med. Malpractice <input type="checkbox"/> 365 Personal Injury—Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 463 Habeas Corpus—Alien Detainee <input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyright <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes

V. ORIGIN (Place an "X" in One Box Only)

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from another district (specify) ☐ 6 Multidistrict Litigation ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

28 USC 1367(a)

Brief description of cause:

Unfair competition and common law trademark infringement

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION DEMAND \$
 UNDER F.R.C.P. 23

VIII. RELATED CASE(S) IF ANY

PLEASE REFER TO CIVIL L.R. 3-12 CONCERNING REQUIREMENT TO FILE "NOTICE OF RELATED CASE".

IX. DIVISIONAL ASSIGNMENT (CIVIL L.R. 3-2) (PLACE AND "X" IN ONE BOX ONLY)

☒ SAN FRANCISCO/OAKLAND☐ SAN JOSEDATE
May 21, 2008

SIGNATURE OF ATTORNEY OF RECORD